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9

10 UNITED STATES DISTRICT COURT  
11 CENTRAL DISTRICT OF CALIFORNIA  
12 SOUTHERN DIVISION

13 JAMES R. GLIDEWELL DENTAL  
CERAMICS, INC. dba GLIDEWELL  
14 LABORATORIES, a California  
corporation,

15 Plaintiff,

16 vs.

17 KEATING DENTAL ARTS, INC., a  
18 California corporation,

19 Defendant.  
20

21 AND RELATED  
22 COUNTERCLAIMS.  
23  
24  
25  
26  
27  
28

Case No. SACV11-01309-DOC (ANx)  
Hon. David O. Carter, Ctrm. 9D

**[PROPOSED] FINAL PRETRIAL  
CONFERENCE ORDER**

Pre-Trial Conf: January 28, 2013  
Jury Trial: February 26, 2013

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1 Following pretrial proceedings, pursuant to Federal Rule of Civil Procedure  
2 16 and Local Rule 16-7, **IT IS ORDERED:**

3 1. The parties are:

- 4 a. Plaintiff and Counterdefendant James R. Glidewell Dental  
5 Ceramics, Inc. (“Glidewell”)  
6 b. Defendant and Counterclaimant Keating Dental Arts, Inc.  
7 (“Keating”).

8 Each of these parties has been served and has appeared.

9 The pleadings which raise the issues are:

- 10 a. Glidewell’s Complaint for (1) Infringement of a Federally  
11 Registered Trademark, (2) False Designation of Origin Under  
12 Lanham Act Section 43(a), and (3) Unfair Competition Under  
13 California Business and Professions Code and Demand for Jury  
14 Trial, filed August 30, 2011 [Dkt. #1];  
15 b. Keating’s Second Amended Answer, Affirmative Defenses, and  
16 Counterclaims, Demand for Jury Trial, filed October 26, 2012  
17 [Dkt. #67], as modified by Keating’s abandonment of its second  
18 counterclaim for unfair competition under California common  
19 law; and  
20 c. Glidewell’s Answer to Counterclaims of Defendant/Counter-  
21 Plaintiff Keating’s Second Amended Answer to Complaint, filed  
22 October 26, 2012 [Dkt. #66].

23 2. Federal jurisdiction and venue are invoked upon the grounds that the  
24 claims in this action arise under the laws of the United States and both parties reside  
25 in this district. The claims at issue arise under federal trademark law, and the Court  
26 has subject matter jurisdiction over these claims under 28 U.S.C. § 1331 and  
27 1338(a). Keating also asserts a claim and defense under California state law, for  
28 which the Court has supplemental jurisdiction under 28 U.S.C. § 1367. Venue is

1 proper in this district, and this Court has personal jurisdiction over Keating, because  
2 defendant Keating has its principal place of business in this District. 28 U.S.C. §§  
3 1391(b) and 1391(c). The facts requisite to federal jurisdiction are admitted.

4 3. The trial is estimated to take eight days.

5 4. The trial is to be a jury trial, with certain claims and requests for relief  
6 to be tried by the Court. At least seven (7) days prior to the trial date  
7 the parties shall lodge and serve by e-mail, fax, or personal delivery:  
8 (a) proposed jury instructions as required by L.R. 51-1 and (b) any  
9 special questions requested to be asked on voir dire.

10 5. The following facts are admitted and require no proof:

- 11 a. James R. Glidewell Dental Ceramics, Inc. (“Glidewell”) is a  
12 California corporation, with its principal place of business in  
13 Newport Beach, California.
- 14 b. Keating Dental Arts, Inc. (“Keating”) is a California  
15 corporation, with its principal place of business in Irvine,  
16 California.
- 17 c. Glidewell is a leading provider of dental restoration products to  
18 dentists.
- 19 d. Glidewell began marketing full contour zirconia crowns and  
20 bridges under the BruxZir mark in June 2009.
- 21 e. Glidewell’s BruxZir mark was registered on the Principal  
22 Register for use in connection with dental bridges, dental caps,  
23 dental crowns, dental inlays, dental onlays, and dental  
24 prostheses on January 19, 2010 as Reg. No. 3,739,663.
- 25 f. Glidewell owns U.S. Trademark Reg. No. 3,739,663, and has  
26 continuously owned U.S. Trademark Reg. No. 3,739,663 from  
27 January 19, 2010 to the present.  
28

g. Keating began marketing full contour zirconia dental crowns and bridges under the KDZ Bruxer mark on or about April 1, 2011.

6. The following facts, though stipulated, shall be without prejudice to any evidentiary objection: None.

7. Claims, Counterclaims and Affirmative Defenses

**Plaintiff:**

a. Glidewell plans to pursue the following claim against Keating:

1. Claim 1: Keating has infringed and continues to infringe Glidewell's rights in its federally registered Trademark Reg. No. 3,739,663 in violation of section 32(a) of the Lanham Act, § 1114;

b. The elements required to establish Glidewell's claim are:

1. Glidewell's Claim 1: Infringement of Federally Registered Trademark

- (a) BruxZir is a valid, protectable trademark;
- (b) Glidewell owns the BruxZir trademark; and
- (c) Keating's use of KDZ Bruxer, without Glidewell's consent, is likely to cause consumer confusion.

*See Ninth Circuit Manual of Model Civil Jury Instructions No. 15.5; Rearden LLC v. Rearden Commerce, Inc.*, 683 F.3d 1190, 1202 (9th Cir. 2012); *Brookfield Communications, Inc. v. West Coast Entertainment Corp.*, 174 F.3d 1036, 1046 (9th Cir. 1999).

2. Glidewell's Claim for Monetary Recovery

- (a) Keating had either statutory or actual notice that Glidewell's trademark was registered (Claim 1 only);



- (b) Keating derived profits from sales of product under the KDZ Bruxer mark; and/or
- (c) Glidewell suffered actual damages due to Keating's sales of product under the KDZ Bruxer mark.

*See Ninth Circuit Manual of Model Civil Jury Instructions Nos. 15.24-26.*

3. Glidewell's Claim for Injunctive Relief

- (a) Glidewell will suffer irreparable injury from continued infringement;
- (b) Remedies available at law are inadequate to compensate for that injury;
- (c) Considering the balance of hardships between the Glidewell and Keating, a remedy in equity is warranted; and
- (d) The public interest would not be disserved by a permanent injunction.

*See Weinberger v. Romero-Barcelo*, 456 U.S. 305, 311-313 (1982); *Marlyn Nutraceuticals, Inc. v. Mucos Pharma GmbH & Go.*, 571 F.3d 873 (9th Cir. 2009); *Brookfield Communications, Inc. v. W. Coast Entm't Corp.*, 174 F.3d 1036 (9th Cir. 1999).

c. In brief, the key evidence Glidewell relies on for its claim is:

1. Glidewell's Claim 1: Infringement of Federally Registered Trademark

- (a) BruxZir is a valid, protectable trademark.

- Testimony of James Shuck concerning creation of the BruxZir mark; advertising and promotion of the BruxZir mark and BruxZir-branded products; development, features, characteristics, and indicated uses of BruxZir-branded products; use of the terms "bruxer" and "bruxer crown" in the dental industry; facts indicating non-genericness of the BruxZir mark; facts indicating the strength of the

1 BruxZir mark and its indication of Glidewell Laboratories as a source of goods and  
2 services.

3 • Testimony of Dr. Michael DiTolla concerning creation of the BruxZir  
4 mark; advertising and promotion of the BruxZir mark and BruxZir-branded  
5 products; development, features, characteristics, and indicated uses of BruxZir-  
6 branded products; use of the terms “bruxer” and “bruxer crown” in the dental  
7 industry; generic terms for full contour zirconia crowns; treatments for patients with  
8 bruxism; facts indicating non-genericness of the BruxZir mark; facts indicating the  
9 strength of the BruxZir mark and its indication of Glidewell Laboratories as a  
10 source of goods and services; facts relating to likelihood of confusion between the  
11 BruxZir mark and “KDZ Bruxer”; pronunciation of the terms “BruxZir” and  
12 “bruxer” by dental practitioners. Expert testimony concerning distinctiveness (and  
13 nongenericness) of the BruxZir mark, including that the mark is suggestive; generic  
14 terms for full contour zirconia crowns; treatments for patients with bruxism.

15 • Testimony of Robin Bartolo concerning use of the terms “bruxer” and  
16 “bruxer crown” in the dental industry; facts indicating non-genericness of the  
17 BruxZir mark; facts indicating the strength of the BruxZir mark and its indication  
18 of Glidewell Laboratories as a source of goods and services; and operation of  
19 Glidewell’s Authorized Labs program, Glidewell Direct, and Glidewell’s  
20 interactions with Authorized BruxZir Labs.

21 • Testimony of Robin Carden concerning development, features,  
22 characteristics, and indicated uses of BruxZir-branded products; use of the terms  
23 “bruxer” and “bruxer crown” in the dental industry; facts indicating non-  
24 genericness of the BruxZir mark; facts indicating the strength of the BruxZir mark  
25 and its indication of Glidewell Laboratories as a source of goods and services; and  
26 Glidewell’s interactions with Authorized BruxZir Labs and operation of  
27 Glidewell’s Authorized Labs program.  
28

1 • Testimony of Rudy Ramirez concerning creation of the BruxZir mark;  
2 development, features, characteristics, and indicated uses of BruxZir-branded  
3 products; use of the terms “bruxer” and “bruxer crown” in the dental industry; facts  
4 indicating non-genericness of the BruxZir mark; facts indicating the commercial  
5 strength of the BruxZir mark and its indication of Glidewell Laboratories as a  
6 source of goods and services.

7 • Testimony of Keith Allred concerning Glidewell’s enforcement of its  
8 rights in the BruxZir mark.

9 • Testimony of Ronald Goldstein, D.D.S. concerning the validity  
10 (distinctiveness and nongenericness) of the BruxZir mark; the conceptual and  
11 commercial strength of the BruxZir mark; and generic terms for full contour  
12 zirconia crowns; treatments for patients with bruxism.

13 • Testimony of David Franklyn concerning the validity (distinctiveness  
14 and nongenericness) of the BruxZir mark, and the conceptual and commercial  
15 strength of the BruxZir mark.

16 • Testimony of one or more of Gregory Doneff, D.D.S., Howard Cohen,  
17 D.D.S., Spencer Luke, D.M.D. , Stuart Newman, D.D.S., Thomas Bell, D.M.D.,  
18 Terence Michiels, D.D.S., Kent Toca, D.D.S. , Dr. Michael Fanning, Dr. Vincent S.  
19 Cianciulli, Dr. Ilya Benjamin, Dr. Dean Saiki, Dr. Robert McNicholas, Dr.  
20 Benjamin An, Dr. Oscar Goren, Dr. Dennis A. Gaishauser, Dr. Chester A. Bizga,  
21 Dr. Valentine Ferraris, Dr. Paul Taylor, Dr. Meredith S. Esposito, or Dr. John  
22 Griffith concerning the validity of the BruxZir mark, the conceptual and  
23 commercial strength of the BruxZir mark; use of the terms “bruxer” and “bruxer  
24 crown” in the dental industry; facts indicating non-genericness of the BruxZir mark;  
25 facts indicating the strength of the BruxZir mark and its indication of Glidewell  
26 Laboratories as a source of goods and services.

27 • Testimony of one or more of Scott Bigler, Glenn Yamamoto, Jacob  
28 Trachsel, or Kareen Chamberlain concerning the validity and commercial strength

1 of the BruxZir mark; and Glidewell Direct and Glidewell's interactions with  
2 Authorized BruxZir Labs.

3 • Testimony of Shaun Keating concerning or constituting admissions  
4 that the BruxZir mark is nongeneric; advertising and promotion of the BruxZir  
5 mark and BruxZir-branded products; development, features, characteristics, and  
6 indicated uses of BruxZir-branded products; use of the terms "bruxer" and "bruxer  
7 crown" in the dental industry; facts indicating non-genericness of the BruxZir mark;  
8 facts indicating the strength of the BruxZir mark and its indication of Glidewell  
9 Laboratories as a source of goods and services.

10 • Testimony of Robert Brandon concerning or constituting admissions  
11 that the BruxZir mark is nongeneric; advertising and promotion of the BruxZir  
12 mark and BruxZir-branded products; development, features, characteristics, and  
13 indicated uses of BruxZir-branded products; use of the terms "bruxer" and "bruxer  
14 crown" in the dental industry; facts indicating non-genericness of the BruxZir mark;  
15 facts indicating the strength of the BruxZir mark and its indication of Glidewell  
16 Laboratories as a source of goods and services.

17 • Reports showing Keating marketing expenses and sales. (Exs. 515,  
18 943-46)

19 • Documents showing Glidewell's expenses to promote and market the  
20 BruxZir mark and BruxZir-branded products. (E.g., Exs. 1550, 1564-68)

21 • Reports showing Glidewell website statistics. (Exs. 1549, 1551-52)

22 • Reports showing unit sales and revenues of BruxZir brand product.  
23 (Exs. 599, 1531-32, 1560-61)

24 • List of Authorized BruxZir Labs. (Ex. 10)

25 • Exemplars of the BruxZir and KDZ Bruxer marks as they appear in the  
26 marketplace. (Exs. 559, 615, 948, 1171, 1176, 1488-91)

27 • Application for the BruxZir mark by Glidewell. (Ex. 608)  
28



1 (c) Keating's use of KDZ Bruxer, without Glidewell's  
2 consent, is likely to cause consumer confusion.

3 • Testimony of James Shuck concerning creation of the BruxZir mark;  
4 advertising and promotion of the BruxZir mark and BruxZir-branded products;  
5 development, features, characteristics, and indicated uses of BruxZir-branded  
6 products; facts indicating the strength of the BruxZir mark and its indication of  
7 Glidewell Laboratories as a source of goods and services; facts relating to  
8 likelihood of confusion between the BruxZir mark and "KDZ Bruxer"; the  
9 commercial strength of the BruxZir mark; the proximity of the goods marketed  
10 under the BruxZir and KDZ Bruxer marks; the channels through which BruxZir and  
11 KDZ Bruxer brand goods are marketed; the type of goods marketed under those  
12 marks; and the degree of care typically used in selecting a particular brand of such  
13 goods.

14 • Testimony of Dr. Michael DiTolla concerning creation of the BruxZir  
15 mark; advertising and promotion of the BruxZir mark and BruxZir-branded  
16 products; facts indicating the strength of the BruxZir mark and its indication of  
17 Glidewell Laboratories as a source of goods and services; facts relating to  
18 likelihood of confusion between the BruxZir mark and "KDZ Bruxer";  
19 pronunciation of the terms "BruxZir" and "bruxer" by dental practitioners; the  
20 commercial strength of the BruxZir mark; the proximity of the goods marketed  
21 under the BruxZir and KDZ Bruxer marks; the channels through which BruxZir and  
22 KDZ Bruxer brand goods are marketed; the type of goods marketed under those  
23 marks; and the degree of care typically used in selecting a particular brand of such  
24 goods. Expert testimony concerning distinctiveness of the BruxZir mark, including  
25 that the mark is suggestive.

26 • Testimony of Nicole Fallon concerning one or more instances of actual  
27 confusion.  
28

1 • Testimony of Robin Bartolo concerning development, features,  
2 characteristics, and indicated uses of BruxZir-branded products; facts indicating the  
3 strength of the BruxZir mark and its indication of Glidewell Laboratories as a  
4 source of goods and services; and operation of Glidewell's Authorized Labs  
5 program, Glidewell Direct, and Glidewell's interactions with Authorized BruxZir  
6 Labs.

7 • Testimony of Robin Carden concerning development, features,  
8 characteristics, and indicated uses of BruxZir-branded products; facts indicating the  
9 strength of the BruxZir mark and its indication of Glidewell Laboratories as a  
10 source of goods and services; Glidewell's interactions with Authorized BruxZir  
11 Labs and operation of Glidewell's Authorized Labs program; and commercial  
12 strength of the BruxZir mark, including technical and educational presentations  
13 concerning BruxZir brand product.

14 • Testimony of Rudy Ramirez concerning creation of the BruxZir mark;  
15 development, features, characteristics, and indicated uses of BruxZir-branded  
16 products; facts indicating the commercial strength of the BruxZir mark and its  
17 indication of Glidewell Laboratories as a source of goods and services.

18 • Testimony of Keith Allred concerning Glidewell's enforcement of its  
19 rights in the BruxZir mark.

20 • Testimony of Ronald Goldstein, D.D.S. concerning the conceptual and  
21 commercial strength of the BruxZir mark; the proximity of the goods marketed  
22 under the BruxZir and KDZ Bruxer marks; the channels through which BruxZir and  
23 KDZ Bruxer brand goods are marketed; the type of goods marketed under those  
24 marks; the degree of care typically used in selecting a particular brand of such  
25 goods; and the likelihood of confusion resulting from Keating's use of KDZ  
26 Bruxer.

27 • Testimony of David Franklyn concerning the conceptual and  
28 commercial strength of the BruxZir mark; the proximity of the goods marketed



1 under the BruxZir and KDZ Bruxer marks; the channels through which BruxZir and  
2 KDZ Bruxer brand goods are marketed; the type of goods marketed under those  
3 marks; the degree of care typically used in selecting a particular brand of such  
4 goods; and the likelihood of confusion resulting from Keating's use of KDZ  
5 Bruxer.

6 • Testimony of one or more of Gregory Doneff, D.D.S., Howard Cohen,  
7 D.D.S., Spencer Luke, D.M.D., Stuart Newman, D.D.S., Thomas Bell, D.M.D.,  
8 Terence Michiels, D.D.S., Kent Toca, D.D.S. , Dr. Michael Fanning, Dr. Vincent S.  
9 Cianciulli, Dr. Ilya Benjamin, Dr. Dean Saiki, Dr. Robert McNicholas, Dr.  
10 Benjamin An, Dr. Oscar Goren, Dr. Dennis A. Gaishauer, Dr. Chester A. Bizga,  
11 Dr. Valentine Ferraris, Dr. Paul Taylor, Dr. Meredith S. Esposito, or Dr. John  
12 Griffith

13 • Testimony of one or more of Scott Bigler, Glenn Yamamoto, Jacob  
14 Trachsel, or Kareen Chamberlain concerning Glidewell Direct and Glidewell's  
15 interactions with Authorized BruxZir Labs; and concerning dentists' interactions  
16 with Authorized BruxZir Labs.

17 • Testimony of Shaun Keating concerning advertising and promotion of  
18 the KDZ Bruxer mark and KDZ Bruxer-branded products; development, features,  
19 characteristics, and indicated uses of KDZ Bruxer-branded products; facts  
20 indicating the strength of the BruxZir mark and its indication of Glidewell  
21 Laboratories as a source of goods and services; facts relating to likelihood of  
22 confusion between the BruxZir mark and "KDZ Bruxer"; the commercial strength  
23 of the BruxZir mark; the proximity of the goods marketed under the BruxZir and  
24 KDZ Bruxer marks; the channels through which BruxZir and KDZ Bruxer brand  
25 goods are marketed; Keating's intent in selecting the KDZ Bruxer mark; the type of  
26 goods marketed under those marks; and the degree of care typically used in  
27 selecting a particular brand of such goods.  
28



1 • Testimony of Robert Brandon concerning advertising and promotion  
2 of the KDZ Bruxer mark and KDZ Bruxer-branded products; development,  
3 features, characteristics, and indicated uses of KDZ Bruxer-branded products; facts  
4 indicating the strength of the BruxZir mark and its indication of Glidewell  
5 Laboratories as a source of goods and services; facts relating to likelihood of  
6 confusion between the BruxZir mark and “KDZ Bruxer”; the commercial strength  
7 of the BruxZir mark; the proximity of the goods marketed under the BruxZir and  
8 KDZ Bruxer marks; the channels through which BruxZir and KDZ Bruxer brand  
9 goods are marketed; Keating’s intent in selecting the KDZ Bruxer mark; the type of  
10 goods marketed under those marks; and the degree of care typically used in  
11 selecting a particular brand of such goods.

12 • Reports showing Keating marketing expenses and sales. (Exs. 515,  
13 943-46)

14 • Documents showing Glidewell’s expenses to promote and market the  
15 BruxZir mark and BruxZir-branded products. (E.g., Exs. 1550, 1564-68)

16 • Reports showing Glidewell website statistics. (Exs. 1549, 1551-52)

17 • Reports showing unit sales and revenues of BruxZir brand product.  
18 (Exs. 599, 1531-32, 1560-61)

19 • List of Authorized BruxZir Labs. (Ex. 10)

20 • Exemplars of the BruxZir and KDZ Bruxer marks as they appear in the  
21 marketplace. (Exs. 559, 615, 948, 1171, 1176, 1488-91)

22 • Call note report, and invoice and fax transmittal, regarding contact  
23 with Dr. Le’s office. (Exs. 556-57)

24 • Keating prescription forms and lab notes. (Exs. 569, 1052, 1121,  
25 1139, 1142, 1160)

26 • Application for the BruxZir mark by Glidewell. (Ex. 608)

27 • Documents showing examination of the BruxZir mark by the U.S.  
28 Patent and Trademark Office. (Exs. 608, 1466, 1467)

- 1 • Trademark Manual of Examining Procedure, 5th Ed. (excerpts). (Ex.  
2 1562)
- 3 • Registration of the BruxZir mark by the U.S. Patent and Trademark  
4 Office. (Ex. 607)
- 5 • Documents showing that the BruxZir mark does not exist in a crowded  
6 field (E.g., Exs. 618, 619)
- 7 • Dictionary excerpts. (E.g., Ex. 614)
- 8 • Advertising, marketing, and promotional material for the BruxZir  
9 mark and BruxZir-branded products. (E.g., Exs. 66-68, 562-568, 570, 575-576,  
10 578-579, 610, 1055-1061)
- 11 • Documents evidencing third party recognition of the BruxZir mark.  
12 (E.g., Exs. 580-591, 594-598)
- 13 • Keating advertising and marketing material for KDZ Bruxer mark and  
14 BruxZir-branded products. (E.g., Exs. 570, 574)
- 15 • Third party advertising and marketing material for full contour  
16 zirconia crowns. (E.g., Exs. 560, 1452)
- 17 • Documents evidencing Glidewell's efforts to protect the BruxZir mark.  
18 (E.g., Exs. 141, 146-151)
- 19 • Documents evidencing Keating's first use of the KDZ Bruxer mark in  
20 the marketplace. (E.g., Ex. 1342)
- 21 • Documents evidencing that neither "bruxzir crown" nor "bruxer  
22 crown" were generic terms for full contour zirconia crowns prior to April 2011.  
23 (E.g., Ex. 2140)
- 24 • Documents evidencing Glidewell's sales, revenues, and gross profit of  
25 BruxZir crowns. (E.g., Exs. 1531, 1532, 1560, 1561, 1566, 1567, 1568)
- 26 • Documents evidencing Keating's sales, revenues, and gross profit of  
27 its KDZ Bruxer crowns. (E.g., Ex. 1051)
- 28

1 In addition, out of an abundance of caution, Glidewell lists some of the key  
2 evidence that it relies on in support of the remedies that it requests, including an  
3 award of damages, an award of Keating's profits, and an injunction.

4 • Testimony of Glenn Sasaki concerning Glidewell's damages and  
5 Keating's profits.

6 • Testimony of Diane Donich concerning Keating's sales of and profits  
7 from sales of product under the KDZ Bruxer mark.

8 • Testimony of James Shuck concerning irreparable harm suffered by  
9 Glidewell as a result of Keating's ongoing infringement.

10 • Testimony of Dr. Michael DiTolla concerning irreparable harm  
11 suffered by Glidewell as a result of Keating's ongoing infringement.


12 • Documents evidencing Glidewell's sales, revenues, and gross profit of  
13 BruxZir crowns. (E.g., Exs. 1531, 1532, 1560, 1561, 1566, 1567, 1568)

14 • Documents evidencing Keating's sales, revenues, and gross profit of  
15 its KDZ Bruxer crowns. (E.g., Ex. 1051)

16 d. **Defendant:**

17 Keating plans to pursue the following counterclaims and  
18 affirmative defenses against Glidewell:

- 19 1. Counterclaim 1: Defendant seeks declaratory judgment  
20 from this Court that its trademark KDZ BRUXER (both  
21 in plain text and stylized logo) does not infringe on any  
22 protectable rights of Plaintiff, including under 15 U.S.C. §  
23 1051 *et seq*;
- 24 2. Counterclaim 2: Plaintiffs' efforts to preclude Defendant  
25 and other competitors from using BRUX or any BRUX-  
26 based term as part of a trademark for zirconia dental  
27 crowns and other dental restorations constitute unfair  
28 competition in violation of California Business &

- 1 Professions Code §17200 *et seq.*, and the common law of  
2 California;
- 3 3. Counterclaim 3: Plaintiff’s present litigation against  
4 Defendant and Plaintiff’s attempts to prevent Defendant  
5 and others from using the generic terms BRUX and/or  
6 BRUXER in the marketplace constitute a misuse of  
7 trademark; and
- 8 4. Counterclaim 4: Due to the generic-ness and/or  
9 commonly descriptive nature of the terms “bruxer” and  
10 “bruxzir,” Trademark Registration No. 3,739,663  
11 (Plaintiff’s BRUXZIR trademark) is invalid and must be  
12 cancelled.
- 13 5. Affirmative Defense 1: Bruxer is a generic and/or  
14 descriptive term within the dental industry and Plaintiff  
15 cannot preclude Defendant from using it. Additionally,  
16 BRUXZIR is phonetically equivalent with the generic  
17 term BRUXER and is therefore invalid and/or  
18 unenforceable;
- 19 6. Affirmative Defense 2: Defendant’s trademarks “KDZ  
20 BRUXER” and are   
21 not confusingly  
22 similar to Plaintiff’s alleged BRUXZIR trademark.
- 23 7. Affirmative Defense 3: Plaintiff is estopped from  
24 asserting that any rights that it may have in the trademark  
25 BRUXZIR are so broad as to cover or include  
26 competitors’ use of the words BRUX or BRUXER within  
27 those competitors’ trademarks because Plaintiff  
28 intentionally chose to adopt, use, and register the

- 1 trademark BRUXZIR, and NOT the words BRUX or  
2 BRUXER.
- 3 8. Affirmative Defense 4: Plaintiff's efforts to prevent  
4 competitors from using the generic term BRUX (and  
5 related terms such as BRUXER) constitute unfair  
6 competition, restraint of trade, and/or misuse of a  
7 trademark, and result in Plaintiff coming to this Court  
8 with unclean hands.
- 9 9. Affirmative Defense 5: Defendant's use of the terms  
10 "Bruxer" and/or "Bruxzir" constitutes fair use.
- 11 e. The elements required to establish Keating's counterclaims and  
12 affirmative defenses are:
- 13 1. Keating's Counterclaim 1: Declaration that Defendant did  
14 not violate 15 U.S.C. § 1114(1) of the Lanham Act:
- 15 (a) To be awarded declaratory relief, Defendant must  
16 establish there is "a case of actual controversy"  
17 within this Court's jurisdiction. 28 U.S.C. §  
18 2201(a).
- 19 (b) To establish Defendant did not infringe on  
20 Plaintiff's BRUXZIR trademark, Defendant must  
21 show that Plaintiff's BRUXZIR mark does not  
22 satisfy one or more of the following elements of  
23 Plaintiff's claim for trademark infringement under  
24 the Lanham Act: (1) BRUXZIR® is a valid  
25 protectable trademark; (2) Plaintiff owns  
26 BRUXZIR® as trademark; and (3) Defendant used  
27 a mark similar to BRUXZIR® without the consent  
28 of the plaintiff in a manner that is likely to cause

1 confusion among ordinary consumers as to the  
2 source, sponsorship, affiliation, or approval of the  
3 goods. *See* Ninth Cir. Manual of Model Civil Jury  
4 Instructions § 15.5 (2010).

5 DISPUTED: Glidewell disputes that Defendant must use a mark similar to  
6 BruxZir in any particular “manner” in order to violate 15 U.S.C. § 1114(1)(a),  
7 which is the provision at issue in this suit. The statute merely requires that  
8 Defendant’s use be “likely to cause confusion, or to cause mistake, or to deceive.”  
9 In addition, Glidewell disputes that Defendant must use its mark so as to cause  
10 confusion as to “the source, sponsorship, affiliation, or approval of the goods.”  
11 Section 1114(1)(a) includes no such requirement.

12 2. Keating’s Counterclaim 2: Violation of California  
13 Business and Professions Code § 17200 *et seq.* are the  
14 same Elements Required to Establish Defendant’s  
15 Counterclaims 3 (Trademark Misuse) and 4 (Invalidity of  
16 Plaintiff’s Trademark)

- 17 (a) “By proscribing ‘any unlawful’ business practice,  
18 section 17200 ‘borrows’ violations of other laws  
19 and treats them as unlawful practices’ that the  
20 unfair competition law makes independently  
21 actionable.” *Cel-Tech Commc’ns, Inc. v. Los*  
22 *Angeles Cellular Telephone Co.*, 20 Cal. 4th 163,  
23 180 (1999).  
24 (b) Thus, the analysis and elements for Defendant’s  
25 counterclaim of unfair competition under California  
26 Business and Professions Code § 17200 *et seq.* are  
27 the same as the analysis and elements for  
28 Defendant’s Counterclaims 3 and 4.

DISPUTED: Glidewell disputes that the elements from Keating's Counterclaim 2 are limited to those of its Counterclaims 3 and 4. In addition to the elements of Counterclaims 3 and 4, Counterclaim 2, requires as an element of the cause of action that Keating show that it has suffered injury in fact and lost money or property as a result of the unfair competition. *See* Cal. Bus. & Prof. Code §§ 17200, 17204.

3. Keating's Counterclaim 3: Misuse of Trademark

(a) A claim of trademark misuse is made applicable by section 33(b)(7) of the Lanham Act (15 U.S.C § 1115(b)(7)), which provides that the certificate of trademark registration shall be conclusive evidence of the registrant's exclusive right to use the trademark except when "the mark has been or is being used to violate the antitrust laws of the United States." *Helene Curtis Indus., Inc. v. Church & Dwight Co., Inc.*, 560 F.2d 1325, 1336 (7th Cir. 1977) (en banc).<sup>1</sup>

(b) Here, Plaintiff has used, and is using, its BRUXZIR registration in an unlawful attempt to prevent Defendant and others from using the generic terms BRUX and/or BRUXER in the marketplace. By its actions, Plaintiff has been, and is attempting to, unfairly compete by asserting an invalid and/or unenforceable trademark in an attempt to

<sup>1</sup> The Seventh Circuit's en banc decision in *Helene Curtis* is cited because there is no relevant decision issued by the Ninth Circuit and *Helene Curtis* is widely regarded as the seminal case authority on the elements of trademark misuse. The Ninth Circuit and the federal trial courts under its jurisdiction have regularly cited the *Helene Curtis* decision on similar and other grounds. *E.g.*, *Coca-Cola Co. v. Overland, Inc.*, 692 F.2d 1250, 1254 n.10 (9th Cir. 1982).



unlawfully monopolize the market for zirconia dental crowns. To establish a claim of monopolization in violation of antitrust laws, Defendant must prove: (1) “that [Plaintiff] has engaged in predatory or anticompetitive conduct”; (2) with a specific intent to monopolize; and (3) dangerous probability of achieving monopoly power. *Coalition for ICANN Transparency, Inc. v. VeriSign, Inc.*, 611 F.3d 495, 506 (9th Cir. 2010); Sherman Act § 2 *et seq.* (15 U.S.C. § 2).

DISPUTED: Trademark misuse is not a recognized or cognizable cause of action; accordingly, elements to prove this claim do not exist. *See, e.g., Juno Online Services v. Juno Lighting, Inc.*, 979 F.Supp. 684 (N.D. Ill. 1997); 6 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition (4th ed. 2010) § 31:44.

In addition, Defendant fails to clearly articulate the elements of any cause of action for trademark misuse. [Dkt. # 199 (“Defendant/Counter-Plaintiff Keating Dental Arts, Inc.’s Memorandum of Contentions of Fact and Law”) pp. 10-11.]

4. Keating’s Counterclaim 4: Cancellation of Plaintiff’s BRUXZIR Trademark as Invalid

- (a) To establish that Plaintiff’s BRUXZIR trademark is invalid due to generic-ness, Defendant must establish that “the primary significance of the [BRUXZIR] trademark [to the prospective purchaser] is to describe the type of product rather than the producer.” *Filipino Yellow Pages, Inc. v. Asian Journal Publs., Inc.*, 198 F.3d 1143, 1147



(9th Cir. 1999) (citation omitted); *see also Kellogg Co. v. National Biscuit Co.*, 305 U.S. 111, 118-119 (1938); *accord* 46 U.S.C. § 1064(3).

(b) To establish that the Plaintiff’s BRUXZIR trademark is invalid due to the commonly descriptive nature of the terms “bruxer” and “bruxzir,” Defendant must establish the terms “bruxer” and “bruxzir” “immediately convey [] knowledge of a quality, feature, function or characteristic of the goods or services with which [they are] used.” *In re Bayer Aktiengesellschaft*, 488 F.3d 960, 963 (Fed. Cir. 2007) (emphasis omitted); *accord* 15 U.S.C. § 1052(e)(1) (“No trademark by which the goods of the applicant may be distinguished from the goods of others shall be refused registration on the principal register on account of its nature unless it--Consists of a mark which (1) when used on or in connection with the goods of the applicant is merely descriptive or deceptively misdescriptive of them[.]”).

(c) To be determined merely descriptive and not entitled to registration, it is sufficient to find that the mark “immediately conveys information about one feature or characteristic of at least one of the designated” goods or services within the applicant’s trademark applications. *In re The Chamber of Commerce of the United States*, 675 F.3d 1297, 1298-1301 (Fed. Cir. 2012) (affirming TTAB

1 decision that the term “National Chamber” was  
2 merely descriptive); *Advertise.com*, 616 F.3d at  
3 982; *Japan Telecom, Inc. v. Japan Telecom Am.,*  
4 *Inc.*, 287 F.3d 866 (9th Cir. 2002).

- 5 (d) Defendant must also establish that BRUXZIR has  
6 not acquired “secondary meaning. *Rudolph Int’l,*  
7 *Inc. v. Realys, Inc.*, 482 F.3d 1195, 1196-98 (9th  
8 Cir. 2007) (“Descriptive terms ‘generally do not  
9 enjoy trademark protection’ but may be protected if  
10 they acquire ‘secondary meaning’ in the minds of  
11 consumers, *i.e.*, [they] become distinctive of the  
12 trademark applicant’s goods in commerce.”) The  
13 Ninth Circuit has enunciated a four-element test the  
14 finder of fact may consider to determine whether a  
15 mark has obtained secondary meaning, including:  
16 “(1) whether actual purchasers of the product  
17 bearing the claimed trademark associate the  
18 trademark with the producer, (2) the degree and  
19 manner of advertising under the claimed trademark,  
20 (3) the length and manner of use of the claimed  
21 trademark, and (4) whether use of the claimed  
22 trademark has been exclusive.” *Yellow Cab Co. of*  
23 *Sacramento v. Yellow Cab of Elk Grove, Inc.*, 419  
24 F.3d 925, 930 (9th Cir. 2005) (citing *Levi Strauss*  
25 *& Co. v. Blue Bell, Inc.*, 778 F.2d 1352, 1358 (9th  
26 Cir. 1985) (en banc)).  
27  
28

1           DISPUTED: To establish that the BruxZir mark is generic, Keating must  
2 overcome the mark's strong presumption of validity. *Zobmondo Enter., LLC v.*  
3 *Falls Media, LLC*, 602 F.3d 1108, 1113, 1121 (9th Cir. 2010). Keating must prove  
4 that ““consumers understand the word to refer only to a particular producer’s  
5 goods [rather than] to refer to the goods themselves.”” *Yellow Cab Co. of*  
6 *Sacramento v. Yellow Cab Co. of Elk Grove, Inc.*, 419 F.3d 925, 929 (9th Cir.  
7 2005). If a buyer understands the term to be identified with a particular producer’s  
8 goods, it is not generic. *Id.* This so even if the source is anonymous to consumers.  
9 *See* 15 U.S.C. § 1127; *Maljack Prods., Inc. v. GoodTimes Home Video Corp.*, 81  
10 F.3d 881, 887 (9th Cir. 1996); 2 McCarthy on Trademarks & Unfair Comp., § 15:8  
11 (4th ed.). “A registered mark shall not be deemed to be the generic name of goods  
12 or services solely because such mark is also used as a name of or to identify a  
13 unique product or service. The primary significance of the registered mark to the  
14 relevant public rather than purchaser motivation shall be the test for determining  
15 whether the registered mark has become the generic name of goods or services on  
16 or in connection with which it has been used.” 15 U.S.C. § 1064(3); *see also*  
17 Ninth Circuit Manual of Model Civil Jury Instructions Nos. 15.9. “The crucial  
18 date for the determination of genericness is the date on which the alleged infringer  
19 entered the market with the disputed mark or term.” *Yellow Cab, Inc.*, 419 F.3d at  
20 928; *see also Nora Beverages, Inc. v. Perrier Grp. of Am., Inc.*, 164 F.3d 736, 744  
21 (2d Cir. 1998); McCarthy § 12:17.50.

22           To establish that the BruxZir mark is descriptive and lacks secondary  
23 meaning, Keating must prove that no mental leap is required to understand the  
24 mark’s relationship to the product. *Zobmondo*, 602 F.3d at 1116. The mental leap  
25 must be almost instantaneous. *Self-Realization Fellowship Church v. Ananda*  
26 *Church of Self-Realization*, 59 F.3d 902, 911 (9th Cir. 1995). Glidewell agrees  
27 that Keating must prove that the BurxZir mark has not acquired “secondary  
28 meaning.” *See* Ninth Circuit Manual of Model Civil Jury Instructions Nos. 15.10,

15.17. Determining whether a descriptive mark has secondary meaning requires consideration of ( 1) whether actual purchasers of the product bearing the mark associate the mark with the producer; (2) the degree and manner of advertising under the mark; (3) the length and manner of use of the mark; and ( 4) whether the use of the mark has been exclusive. *Yellow Cab*, 419 F.3d at 930. Additional pertinent factors include the mark holder's amount of sales and number of customers, and intentional copying by the infringer. *Filipino Yellow Pages, Inc. v. Asian Journal Pub'ns, Inc.*, 198 F.3d 1143, 1151 (9th Cir. 1999).

5. Keating's Affirmative Defense 1: BRUXER is generic and/or commonly descriptive term; BRUXZIR trademark is invalid due to generic-ness

(a) To establish that BRUXER is generic such that Plaintiff may not preclude Defendant from using it, Defendant must establish that "the primary significance of the [BRUXZIR] trademark [to the prospective purchaser] is to describe the type of product rather than the producer." *Filipino Yellow Pages*, 198 F.3d at 1147 (citation omitted); see also *Kellogg*, 305 U.S. at 118-119; 46 U.S.C. § 1064(3).

(b) To establish that BRUXOR is merely descriptive such that Plaintiff may not preclude Defendant from using it, Defendant must establish the terms "bruxer" and "bruxzir" "immediately convey [] knowledge of a quality, feature, function or characteristic of the goods or services with which [they are] used." *In re Bayer Aktiengesellschaft*, 488 F.3d at 963 (emphasis omitted); accord 15 U.S.C. § 1052(e)(1). To be determined merely

descriptive and not entitled to registration, it is sufficient to find that the mark “immediately conveys information about one feature or characteristic of at least one of the designated” goods or services within the applicant’s trademark applications. *In re The Chamber of Commerce of the United States*, 675 F.3d at 1298-1301 (affirming TTAB decision that the term “National Chamber” was merely descriptive); *Advertise.com, Inc. v. AOL Advertising, Inc.*, 616 F.3d 974, 982 (9th Cir. 2010); *Japan Telecom*, 287 F.3d at 866. Defendant must also establish that BRUXZIR has not acquired “secondary meaning. *Rudolph Int’l*, 482 F.3d at 1196-98 (“Descriptive terms ‘generally do not enjoy trademark protection’ but may be protected if they acquire ‘secondary meaning’ in the minds of consumers, i.e., [they] become distinctive of the trademark applicant’s goods in commerce.”) “To establish secondary meaning, a manufacturer must show that, in the minds of the public, the primary significance of a product feature or term is to identify the source of the product rather than the product itself.” *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 766 (1992) (citing *Inwood Labs., Inc. v. Ives Labs., Inc.*, 456 U.S. 844 (1982)).

(c) Because Plaintiff’s BRUXZIR is phonetically equivalent to BRUXER, Defendant can establish that Plaintiff’s BRUXZIR trademark is invalid

1 and/or unenforceable by also establishing  
2 BRUXER is a generic and/or merely descriptive  
3 term.

4 DISPUTED: To establish that the BruxZir mark is generic, Keating must  
5 overcome the mark's strong presumption of validity. *Zobmondo Enter., LLC v.*  
6 *Falls Media, LLC*, 602 F.3d 1108, 1113, 1121 (9th Cir. 2010). Keating must prove  
7 that “consumers understand the word to refer only to a particular producer’s  
8 goods [rather than] to refer to the goods themselves.” *Yellow Cab Co. of*  
9 *Sacramento v. Yellow Cab Co. of Elk Grove, Inc.*, 419 F.3d 925, 929 (9th Cir.  
10 2005). If a buyer understands the term to be identified with a particular producer’s  
11 goods, it is not generic. *Id.* This so even if the source is anonymous to consumers.  
12 *See* 15 U.S.C. § 1127; *Maljack Prods., Inc. v. GoodTimes Home Video Corp.*, 81  
13 F.3d 881, 887 (9th Cir. 1996); 2 McCarthy on Trademarks & Unfair Comp., § 15:8  
14 (4th ed.). “A registered mark shall not be deemed to be the generic name of goods  
15 or services solely because such mark is also used as a name of or to identify a  
16 unique product or service. The primary significance of the registered mark to the  
17 relevant public rather than purchaser motivation shall be the test for determining  
18 whether the registered mark has become the generic name of goods or services on  
19 or in connection with which it has been used.” 15 U.S.C. § 1064(3); *see also*  
20 Ninth Circuit Manual of Model Civil Jury Instructions Nos. 15.9. “The crucial  
21 date for the determination of genericness is the date on which the alleged infringer  
22 entered the market with the disputed mark or term.” *Yellow Cab, Inc.*, 419 F.3d at  
23 928; *see also Nora Beverages, Inc. v. Perrier Grp. of Am., Inc.*, 164 F.3d 736, 744  
24 (2d Cir. 1998); McCarthy § 12:17.50.

25 To establish that the BruxZir mark is descriptive and lacks secondary  
26 meaning, Keating must prove that no mental leap is required to understand the  
27 mark's relationship to the product. *Zobmondo*, 602 F.3d at 1116. The mental leap  
28 must be almost instantaneous. *Self-Realization Fellowship Church v. Ananda*

1 *Church of Self-Realization*, 59 F.3d 902, 911 (9th Cir. 1995). Glidewell agrees  
2 that Keating must prove that the BurxZir mark has not acquired “secondary  
3 meaning.” *See* Ninth Circuit Manual of Model Civil Jury Instructions Nos. 15.10,  
4 15.17. Determining whether a descriptive mark has secondary meaning requires  
5 consideration of ( 1) whether actual purchasers of the product bearing the mark  
6 associate the mark with the producer; (2) the degree and manner of advertising  
7 under the mark; (3) the length and manner of use of the mark; and (4) whether the  
8 use of the mark has been exclusive. *Yellow Cab*, 419 F.3d at 930. Additional  
9 pertinent factors include the mark holder's amount of sales and number of  
10 customers, and intentional copying by the infringer. *Filipino Yellow Pages, Inc. v.*  
11 *Asian Journal Pub'ns, Inc.*, 198 F.3d 1143, 1151 (9th Cir. 1999).

12 Glidewell disputes that BruxZir is phonetically equivalent to Bruxer, and that  
13 Defendant can establish that Glidewell's BruxZir trademark is invalid and/or  
14 unenforceable if BRUXER is a generic and/or merely descriptive term.

15 6. Keating’s Affirmative Defense 2: No Likelihood of  
16 Confusion

- 17 (a) To establish that Defendant’s use of the KDZ  
18 BRUXER mark does not cause a likelihood of  
19 confusion as to the source of Defendant’s or  
20 Plaintiff’s goods, Defendant must generally  
21 demonstrate that the following non-exclusive  
22 factors of the Sleekcraft test weigh in Defendant’s  
23 favor:
- 24 (b) Strength or Weakness of the Plaintiff’s Mark. The  
25 more the consuming public recognizes the  
26 plaintiff’s trademark as an indication of origin of  
27 the plaintiff’s goods, the more likely it is that  
28 consumers would be confused about the source of



the defendant's goods if the defendant uses a similar mark.

(c) Defendant's Use of the Mark. If the defendant and plaintiff use their trademarks on the same, related, or complementary kinds of goods, there may be a greater likelihood of confusion about the source of the goods than otherwise.

(d) Similarity of Plaintiff's and Defendant's Marks. If the overall impression created by the plaintiff's trademark in the marketplace is similar to that created by the defendant's trademark in appearance, sound, or meaning, there is a greater chance that the relevant consumers are likely to be confused by defendant's use of a mark.

(e) Actual Confusion. If use by the defendant of the plaintiff's trademark has led to instances of actual confusion, this strongly suggests a likelihood of confusion. However actual confusion is not required for a finding of likelihood of confusion. Even if actual confusion did not occur, the defendant's use of the trademark may still be likely to cause confusion. As the Court considers whether the trademark used by the defendant creates for consumers a likelihood of confusion with the plaintiff's trademark, the Court should weigh any instances of actual confusion against the opportunities for such confusion. If the instances of actual confusion have been relatively frequent, the



1 Court may find that there has been substantial  
2 actual confusion. If, by contrast, there is a very  
3 large volume of sales, but only a few instances of  
4 actual confusion, the Court may find that there has  
5 not been substantial actual confusion.

6 (f) Defendant's Intent. Knowing use by defendant of  
7 the plaintiff's trademark to identify similar goods  
8 may strongly show an intent to derive benefit from  
9 the reputation of the plaintiff's mark, suggesting an  
10 intent to cause a likelihood of confusion. On the  
11 other hand, even in the absence of proof that the  
12 defendant acted knowingly, the use of plaintiff's  
13 trademark to identify similar goods may indicate a  
14 likelihood of confusion.

15 (g) Marketing/Advertising Channels. If the plaintiff's  
16 and defendant's goods are likely to be sold in the  
17 same or similar stores or outlets, or advertised in  
18 similar media, this may increase the likelihood of  
19 confusion.

20 (h) Consumer's Degree of Care. The more  
21 sophisticated the potential buyers of the goods or  
22 the more costly the goods, the more careful and  
23 discriminating the reasonably prudent purchaser  
24 exercising ordinary caution may be. They may be  
25 less likely to be confused by similarities in the  
26 plaintiff's and defendant's trademarks.

27 (i) Product Line Expansion. When the parties'  
28 products differ, the Court may consider how likely

the plaintiff is to begin selling the products for which the defendant is using the plaintiff's trademark. If there is a strong possibility of expanding into the other party's market, there is a greater likelihood of confusion.

(j) *See* Ninth Cir. Manual of Model Civil Jury Instructions § 15.16 (2010); *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979).

DISPUTED: The Sleekcraft factors (items (b) to (j) above) are not elements of the cause of action for infringement of a registered mark, but rather are merely factors that the courts look to for guidance in determining whether the alleged infringer's use of the accused mark is likely to cause confusion. The elements of a claim for infringement of a registered mark are set forth above at page 3, section 7(b).

7. Keating's Affirmative Defense 3: Estoppel

(a) There are four elements for the affirmative defense of estoppel: (1) Plaintiff communicated something in a misleading way, either by words, conduct or silence; (2) Defendant relied upon that communication; (3) Defendant was ignorant of the matter asserted by Plaintiff; and (4) Defendant would be harmed materially if the other party is permitted to assert any claim inconsistent with his earlier conduct. *See Kierulff v. Metro. Stevedore Co.*, 315 F.2d 839, 842 (9th Cir. 1963).

DISPUTED: The elements of the affirmative defense of estoppel are:

a. Glidewell must be apprised of the facts;

- 1 b. Glidewell must intend that its conduct shall be acted  
2 upon, or must so act that Keating has a right to believe it  
3 was so intended;  
4 c. Keating must be ignorant of the true state of facts; and  
5 d. Keating must justifiably rely upon the conduct to its  
6 injury.

7 *See Cox v. Ocean View Hotel Corp.*, 533 F.3d 1114, 1123 (9th Cir. 2008);  
8 *Nat. Ass’n of Realtors v. Champions Real Estate Services Inc.*, 812 F. Supp. 2d  
9 1251, 1262 (W.D. Wash. 2011).

10 8. Keating’s Affirmative Defense 4: Misuse of  
11 Trademark/Unclean Hands/Unfair Competition

12 (a) The affirmative defense of trademark misuse is  
13 made applicable by section 33(b)(7) of the Lanham  
14 Act (15 U.S.C. § 1115(b)(7)), which provides that  
15 the certificate of trademark registration shall be  
16 conclusive evidence of the registrant's exclusive  
17 right to use the trademark except when “[t]hat the  
18 mark has been or is being used to violate the  
19 antitrust laws of the United States.” *Helene Curtis*  
20 *Indus.*, 560 F.2d at 1336.

21 (b) Here, Plaintiff has used and is using its BRUXZIR  
22 registration in an unlawful attempt to prevent  
23 Defendant and others from using the generic terms  
24 BRUX and/or BRUXER in the marketplace. By its  
25 actions, Plaintiff has been and is attempting to  
26 unfairly compete by asserting an invalid and/or  
27 unenforceable trademark in an attempt to  
28 unlawfully monopolize the market for zirconia

dental crowns. To establish a claim of monopolization in violation of the Sherman Antitrust Act, Defendant must prove: (1) “that [Plaintiff] has engaged in predatory or anticompetitive conduct”; (2) with a specific intent to monopolize; and (3) dangerous probability of achieving monopoly power. *Coalition for ICANN Transparency*, 611 F.3d at 506; Sherman Act § 2 *et seq.* (15 U.S.C. § 2).

(c) “To make out an unclean hands defense, a trademark defendant ‘must demonstrate that the plaintiff’s conduct is inequitable and that the conduct relates to the subject matter of its claims.’ *Fuddruckers, Inc. v. Doc’s B.R. Others, Inc.*, 826 F.2d 837, 847 (9th Cir. 1987). To show that a trademark plaintiff’s conduct is inequitable, defendant must show that plaintiff used the trademark to deceive consumers, *see Dollar Sys., Inc. v. Avcar Leasing Sys., Inc.*, 890 F.2d 165, 173 (9th Cir.1989) (“Bad intent is the essence of the defense of unclean hands.”) (citing *Wells Fargo & Co. v. Stagecoach Props., Inc.*, 685 F.2d 302, 308 (9th Cir.1982)); *Republic Molding Corp. v. B.W. Photo Utils.*, 319 F.2d 347, 350 (9th Cir.1963).” *Japan Telecom*, 287 F.3d at 870-71.

DISPUTED: Keating must prove the following by *clear and convincing evidence*:

- a. Glidewell has committed egregious conduct that violates conscience, good faith, or other equitable principles in its prior conduct, or has dirtied its hands in acquiring the right presently asserted; and
- b. Glidewell's misconduct relates directly to the transaction concerning which the complaint is made.

*See PomWonderful LLC v. Welch Foods, Inc.*, 737 F. Supp. 2d 1105, 1113 (C.D. Cal. 2010); *Dollar Systems, Inc. v. Avcar Leasing Systems, Inc.*, 890 F.2d 165, 173 (9th Cir. 1989); *KEMA, Inc. v. Koperwhats*, 658 F.Supp.2d 1022, 1035-36 (N.D. Cal. 2009) (defense of misuse of trademark is redundant with unclean hands).

9. Keating's Affirmative Defense 5: Fair Use

- (a) To establish "classic" fair use, Defendant must show its use of "Bruxer" is (1) not a use "as a trademark or service mark"; (2) done "fairly and in good faith"; and (3) "[o]nly to describe its goods or services." *Cairns v. Franklin Mint Co.*, 292 F.3d 1139, 1150-51 (9th Cir. 2002); Ninth Cir. Manual of Model Civil Jury Instructions § 15.22 (2010).

- f. In brief, the key evidence Keating relies on for each counterclaim and affirmative defense is:

1. Keating's Counterclaim 1: Declaration of Non-infringement:

- Plaintiff's BRUXZIR mark is not entitled to trademark protection because the term "BruxZir" is generic and/or commonly descriptive:
  - "BruxZir" and the generic term "bruxer" are pronounced identically. (Mangum Decl., Ex. 50 (Shuck Dep. Tr.) at 73:16-74:18; 128:9-20; Eggleston Decl., Ex. 65 at 16; Van Hoosear Decl., Ex. V-4; Boatright Decl., Ex. A ¶ 27 (Glidewell

1 promotional video where Glidewell’s Director of Clinical  
2 Education and Research, Dr. DiTolla, pronounces BRUXZIR  
3 and “bruxer” identically));<sup>2</sup>  
4 • Glidewell itself uses “BruxZir” generically. In their  
5 videotaped depositions in this case, Glidewell’s witnesses  
6 pronounced “BruxZir” and “bruxer” identically. (Van Hoosear  
7 Decl., Exs. V-1, V-2, V-3);  
8 • The many labs that Glidewell has authorized to make and sell  
9 crowns made from its “BruxZir” material (including at least  
10 one who previously received cease-and-desist letters) do not  
11 identify Glidewell as the source. (Eggleston Decl., Exs. 136 &  
12 137);  
13 • Dentists and dental labs use and understand the term  
14 “BruxZir” as a generic term to identify a crown for “bruxers”  
15 (individuals who grind their teeth). (Boatright Decl., Ex. A ¶  
16 27 (First video link); Eggleston Decl., Ex. 65, at 17:3-8;  
17 Eggleston Decl. ¶ 17, Ex. 65, at 16:10–17:12; Jankowski  
18 Decl., Ex. 4 (DiTolla Dep. Tr.), at 35:15-22, 80:10–81:10,  
19 224:13–226:6; Jankowski Decl., Ex. 6 (Allred Dep. Tr.), at  
20 195:22–196:1; Mangum Decl., Ex. 50 (Shuck Dep. Tr.), at  
21 33:13–34:17, 235:3-10; Van Hoosear Decl., Exs. V-1 (Shuck  
22 Dep. Video Clips), V-2 (DiTolla Dep. Video Clips), V-3  
23 (Carden Dep. Video Clips), V-4 (Compendium Clips) (“this  
24 Bruxzir is 100% zirconia” and “one question I get about  
25 Bruxzirs is . . .” and “We do 15,000, say, BruxZirs a week.”));  
26

27 <sup>2</sup> The declarations referenced in this section (I.C(a)(1)) are the declarations filed in  
28 support of Defendant’s Motion for Summary Judgment Cancelling Glidewell’s  
Trademark Registration [Dkt. No. 85] and referenced in Defendant’s Statement of  
Uncontroverted Facts and Conclusions of Law in Support that Motion.

- In addition to Glidewell and Keating, many other dental laboratories have been offering all-zirconia crowns under a variety of names, including names with “Brux,” “Zir,” or some variation thereof. Examples include:
  - Advanced Dental Lab - BruxZir (Jankowski Decl. Ex. 31)
  - Assured Dental Lab - Z-Brux (Jankowski Decl. Ex. 28)
  - Authentic Dental Lab - Brux (Jankowski Decl. Ex. 27)
  - Barth Dental Lab - Z-Brux (Jankowski Decl. Exs. 34 & 37)
  - Burbank Dental - Zir-Max (Eggleston Decl. Ex. 99)
  - California Dental Arts - ZirFit (Eggleston Decl. Ex. 103)
  - CDLLab - ZerisBRUX (Eggleston Decl. Ex. 109)
  - China Dental Outsourcing - “Bruxer All Zirconia” (Jankowski Ex. 29)
  - China Dental Outsourcing - All Zirconia for Bruxers (Jankowski Ex. 39)
  - Continental Dental - Full Zirconia for Bruxing Patients (Eggleston Decl. Ex. 112)
  - Cosmetic Dentistry of SA - Bruxer Crown (Eggleston Decl. Ex. 119)
  - Dani Dental - Full Zirconia (Bruxer) (Jankowski Ex. 43)
  - Diadem Precision Technology - Diazir (Eggleston Decl., Ex. 101)
  - Drake Dental - Zir-Cast (Eggleston Decl. Ex. 96)
  - Expertec - Full-Z (Eggleston Decl. Ex. 93)
  - Fusion Dental Lab - “Full Solid Bruxer Zirconia” (Jankowski Ex. 24)
  - GPS Dental Lab - GPS BruxArt (Eggleston Decl. Ex.



- 114)
- Infinity Dental Lab - Bruxer Crowns (Eggleston Decl. Ex. 108)
  - Kastle Mills - ZirCrown (Eggleston Decl. Ex. 100)
  - Mascola Esthetics - Xtreme Bruxer (Eggleston Decl. Ex. 110)
  - Old Dominion Milling Corp. - Bruxzer (Jankowski Ex. 32)
  - Pittman Dental - ZirCAM All-Zirconia (Eggleston Decl. Ex. 106)
  - Pittman Dental - Bruxer Crown (Eggleston Decl. Ex. 120)
  - R-dent Dental Laboratory - R-Brux (Eggleston Decl. Ex. 117)
  - Showcase Dental Lab - Zir-Bruxer (Jankowski Exs. 30 & 38)
  - Somer Dental Labs - Full Contour Zir (Eggleston Decl. Ex. 104)
  - Summers Dental Lab - BruxThetix (Eggleston Decl. Ex. 113)
  - Sun Dental Labs - Suntech Full Zirconia (Eggleston Decl. Ex. 94)
  - Technics Dental Lab - Tech/ZIR FC (Eggleston Decl. Ex. 105)
  - Trachsel Dental - All Zirconia Bruxer (Jankowski Ex. 42)
  - York Dental Lab - Bruxer (Eggleston Decl., Ex. 111)
- Many dental laboratories prominently promote their all-zirconia crowns for use by bruxers:
    - Barth Dental Labs - “ideal for bruxers” (Jankowski Ex.

- 37)
- California Dental Arts - “Perfect for bruxers” (Eggleston Decl. Ex. 103)
  - China Dental Outsourcing - “primarily for bruxers and heavy biters” (Jankowski Ex. 39)
  - Drake Dental - “Recommended for Bruxers and Grinders” (Eggleston Decl. Ex. 96)
  - Expertec - “ideal for patients who brux” (Eggleston Decl. Ex. 93)
  - Infinity Dental Lab - “Bruxer Crowns” (Eggleston Decl. Ex. 108)
  - Sun Dental Labs - for “bruxers and grinders” (Eggleston Decl. Ex. 94)
  - York Dental Lab - “ideal restoration for bruxers” (Eggleston Decl. Ex. 111)
- Dentists have repeatedly written the word “Bruxzir” on prescription forms to refer to Defendant’s KDZ BRUXER all-zirconia crown or to a generic reference to an all-zirconia crown, not to identify Plaintiff Glidewell as a source. (Mangum Decl. Ex. 53 (Brandon Dep. Tr.) at 56:23-57:6 & Exs. 59, 61, 62; Belton Decl. ¶¶ 9-11; Brady Decl. ¶¶ 9-11; Campbell Decl. ¶¶ 10-12; Colleran Decl. ¶¶ 10-12; Jacquinet Decl. ¶¶ 9-10; Murphy Decl. ¶¶ 9-11; Myers Decl. ¶¶ 9-10; Nussear Decl. ¶¶ 9-11; Richardson Decl. ¶ 10-12; Scott Decl. ¶¶ 9-11; Stephens Decl. ¶¶ 10-12; Sweet Decl. ¶¶ 8-10; Tobin Decl. ¶¶ 9-11)
  - Showcase Dental Laboratory, a dental lab unaffiliated with Plaintiff Glidewell or Defendant Keating, has also received

prescription forms from dentists ordering all-zirconia crowns that generically describe an all-zirconia crown as a “BruxZir,” “bruxzir,” or some variation thereof. (Eggleston Decl. Ex. 65 at 16-18 & Ex. 66 at 3-7.)

- Plaintiff owns BRUXZIR® as trademark.
- Defendant did not use its KDZ BRUXER mark in a manner likely to cause confusion among ordinary consumers as to the source, sponsorship, affiliation, or approval of the goods.
  - Plaintiff’s BRUXZIR mark is extremely weak because the term “BruxZir” is generic and/or commonly descriptive. (*See* evidence listed above in Section I.C.(a)(1).)
  - Declarations from thirteen dentists (identified in the following list) stating that they wrote “BruxZir,” “bruxzir,” or variations thereof on their prescription forms as a generic reference to an all-zirconia crown, not because they wanted a crown from Glidewell and not because they were otherwise confused that Glidewell and Keating were affiliated:

Belton Decl. ¶¶ 9-11, Ex. A;	Brady Decl. ¶¶ 9-11, Ex. A;
Campbell Decl. ¶¶ 10-12, Ex. A;	Colleran Decl. ¶¶ 10-12, Ex. A;
Jacquinet Decl. ¶¶ 9-10, Ex. A;	Murphy Decl. ¶¶ 9-11, Ex. A;
Myers Decl. ¶¶ 9-10, Ex. B;	Nussear Decl. ¶¶ 9-11, Ex. A;
Richardson Decl. ¶¶ 10-12, Ex. A;	Scott Decl. ¶¶ 9-11, Ex. A;
Stephens Decl. ¶¶ 10-12, Ex. A;	Sweet Decl. ¶¶ 8-10, Ex. A; and
Tobin Decl. ¶¶ 9-11, Ex. A.	

- Plaintiff’s mark, as used in commerce, includes two separate words: “KDZ Bruxer” or “KDZ BRUXER.” In contrast, Glidewell’s mark is presented in commerce as a single word

1 comprising a mixture of capital and small letters and two  
2 different fonts: BruxZir.

- 3 • Furthermore, in Glidewell's mark, the "Zir" portion cuts off  
4 the edge of the "x" giving the appearance that the "Zir" letters  
5 appear forward of the word "Brux."

6 **BruxZir®**

7  
8 In contrast, Keating's mark uses block letters side-by-side, often  
9 presented as part of a design that includes the name within an  
10 oval:



13 These additional elements help distinguish the parties' marks as  
14 used in commerce.

- 15 • The second part of Keating's mark is pronounced identically  
16 as Glidewell's mark in its entirety. (See evidence listed  
17 immediately above in Section III.C.(1).) The first part of  
18 Keating's mark, "KDZ," has no similarly sounding counterpart  
19 in Glidewell's mark  
20  
21 • The purchasing public (dentists) interpret Glidewell's mark  
22 and the *second part* of Keating's mark as a reference to the  
23 product itself: an all-zirconia dental restoration crown strong  
24 enough for bruxers. Dentists interpret the first part of  
25 Keating's mark, "KDZ," to mean "Keating Dental Zirconia,"  
26 thus identifying the source of the goods: Keating Dental Arts,  
27  
28

Inc. (Keating Decl. ¶ 11; Stephens Decl. ¶ 10; Campbell Decl. ¶ 6.)<sup>3</sup>

2. Keating’s Counterclaim 2: Violation of California Business and Professions Code § 17200 *et seq.*

- Because California Business and Profession Code § 17200 *et seq.* is a borrowing statute, the analysis for Counterclaim 2 is identical to the analysis of Counterclaims 3 and 4. Likewise, the evidence in support of Counterclaim 2 is the same evidence in support of Counterclaims 3 and 4.

3. Keating’s Counterclaim 3: Misuse of Trademark

- Plaintiff has engaged in predatory or anticompetitive conduct:

Plaintiff has relied on the registration of its BRUXZIR mark as grounds for threatening trademark infringement suits against any other dental laboratory using “Brux” or “Bruxer” in a mark for an all-zirconia crown. (Jankowski Decl., Ex. 6 (Allred Dep. Tr.) at 213:19-264:13 & Exs. 24-34.)<sup>4</sup> Specifically, Plaintiff sent cease-and-desist letters to at least the following dental labs:

- Assured Dental Lab - “Z-Brux” (Jankowski Decl. Ex. 28)
- Authentic Dental Lab - “Brux” (Jankowski Decl. Ex. 27)
- China Dental Outsourcing - “Bruxer All Zirconia” (Jankowski Decl. Ex. 29)
- Fusion Dental Lab - “Full Solid Bruxer Zirconia” (Jankowski Decl. Ex. 24)

<sup>3</sup> The declarations referenced in this section (II.C.(a)(3)) are the declarations filed in support of Keating Dental Arts, Inc.’s Motion for Summary Judgment of Noninfringement of Glidewell’s BRUXZIR® Trademark [Dkt. No. 86] and referenced in Defendant’s Statement of Uncontroverted Facts and Conclusions of Law in Support of that Motion.

<sup>4</sup> The declarations referenced in this section (II.C(c)(1)) are the declarations filed in support of Defendant’s Motion for Summary Judgment Cancelling Glidewell’s Trademark Registration [Dkt. No. 85] and referenced in Defendant’s Statement of Uncontroverted Facts and Conclusions of Law in Support that Motion.

- Old Dominion Milling Corp. - “Bruxzer” (Jankowski Decl. Ex. 32)
- Pittman Dental - “Bruxer All-Zirconia Crown” (Jankowski Decl. Ex. 25)
- R-dent Dental Laboratory - “R-Brux” (Jankowski Decl. Ex. 26)
- Showcase Dental Lab - “Zir-Bruxer”) (Jankowski Decl. Ex. 30)

In each instance, the dental laboratory chose to change its name rather than face the risk of a lawsuit in Federal court versus Plaintiff. (*Id.*; Jankowski Decl. Ex. 6 (Allred Dep. Tr.) at 213:19-264:13.)

- Plaintiff had a specific intent to monopolize for all-zirconian bruxer:

Please see the evidence cited in the previous section (II.C(c)(1)).

- There is a dangerous probability Plaintiff could achieve monopoly power:

Please see the evidence cited above in section II.C(c)(1). Furthermore, Plaintiff Glidewell Laboratories, founded in 1970, is already the largest dental laboratory in the U.S. (Jankowski Decl., Ex. 6 (Allred Dep. Tr.) at 51).

#### 4. Keating’s Counterclaim 4: Cancellation of Trademark

- Plaintiff’s BRUXZIR trademark is invalid due to generic-ness and because the terms “bruxzir” is commonly descriptive:

Please see the evidence cited above in Section 7(Defendant)(c)(1).

- Plaintiff’s BRUXZIR mark has not acquired “secondary meaning”:

In addition to describing the intended user of the product—a bruxer—the evidence establishes that dentists and dental labs understand the term BRUXZIR to denote or at least describe full zirconia crown products that are ideal for bruxers. Plaintiff’s witnesses testified to such descriptive attributes of the “brux” and “zir” elements of the mark. (*See* evidence cited above in Section I.C(a)(3).) Plaintiff has failed to submit any survey evidence or other evidence showing an association of its BRUXZIR mark in the minds of the relevant consumers. Additionally, Plaintiff has failed to submit any evidence that its advertising was effective in establishing

secondary meaning in the minds of the relevant consumers

5. Keating's Affirmative Defense 1: Invalidity of Plaintiff's Trademark due to Generic-ness

- Plaintiff's BRUXZIR mark is not entitled to trademark protection because the term "BruxZir" is generic and/or commonly descriptive:
  - "BruxZir" and the generic term "bruxer" are pronounced identically. (Mangum Decl., Ex. 50 (Shuck Dep. Tr.) at 73:16-74:18; 128:9-20; Eggleston Decl., Ex. 65 at 16; Van Hoosear Decl., Ex. V-4; Boatright Decl., Ex. A ¶ 27 (Glidewell promotional video where Glidewell's Director of Clinical Education and Research, Dr. DiTolla, pronounces BRUXZIR and "bruxer" identically));<sup>5</sup>
  - Glidewell itself uses "BruxZir" generically. In their videotaped depositions in this case, Glidewell's witnesses pronounced "BruxZir" and "bruxer" identically. (Van Hoosear Decl., Exs. V-1, V-2, V-3);
  - The many labs that Glidewell has authorized to make and sell crowns made from its "BruxZir" material (including at least one who previously received cease-and-desist letters) do not identify Glidewell as the source. (Eggleston Decl., Exs. 136 & 137);
  - Dentists and dental labs use and understand the term "BruxZir" as a generic term to identify a crown for "bruxers" (individuals who grind their teeth). (Boatright Decl., Ex. A ¶ 27 (First video link); Eggleston Decl., Ex. 65, at 17:3-8;

<sup>5</sup> The declarations referenced in this section (I.C(a)(1)) are the declarations filed in support of Defendant's Motion for Summary Judgment Cancelling Glidewell's Trademark Registration [Dkt. No. 85] and referenced in Defendant's Statement of Uncontroverted Facts and Conclusions of Law in Support that Motion.



1 Eggleston Decl. ¶ 17, Ex. 65, at 16:10–17:12; Jankowski  
2 Decl., Ex. 4 (DiTolla Dep. Tr.), at 35:15–22, 80:10–81:10,  
3 224:13–226:6; Jankowski Decl., Ex. 6 (Allred Dep. Tr.), at  
4 195:22–196:1; Mangum Decl., Ex. 50 (Shuck Dep. Tr.), at  
5 33:13–34:17, 235:3–10; Van Hoosear Decl., Exs. V-1 (Shuck  
6 Dep. Video Clips), V-2 (DiTolla Dep. Video Clips), V-3  
7 (Carden Dep. Video Clips), V-4 (Compendium Clips) (“this  
8 Bruxzir is 100% zirconia” and “one question I get about  
9 Bruxzirs is . . .” and “We do 15,000, say, BruxZirs a week.”));

- 10 • In addition to Glidewell and Keating, many other dental  
11 laboratories have been offering all-zirconia crowns under a  
12 variety of names, including names with “Brux,” “Zir,” or some  
13 variation thereof. Examples include:

- 14 ○ Advanced Dental Lab - BruxZir (Jankowski Decl. Ex. 31)
- 15 ○ Assured Dental Lab - Z-Brux (Jankowski Decl. Ex. 28)
- 16 ○ Authentic Dental Lab - Brux (Jankowski Decl. Ex. 27)
- 17 ○ Barth Dental Lab - Z-Brux (Jankowski Decl. Exs. 34 &  
18 37)
- 19 ○ Burbank Dental - Zir-Max (Eggleston Decl. Ex. 99)
- 20 ○ California Dental Arts - ZirFit (Eggleston Decl. Ex. 103)
- 21 ○ CDLLab - ZerisBRUX (Eggleston Decl. Ex. 109)
- 22 ○ China Dental Outsourcing - “Bruxer All Zirconia”  
23 (Jankowski Ex. 29)
- 24 ○ China Dental Outsourcing - All Zirconia for Bruxers  
25 (Jankowski Ex. 39)
- 26 ○ Continental Dental - Full Zirconia for Bruxing Patients  
27 (Eggleston Decl. Ex. 112)
- 28 ○ Cosmetic Dentistry of SA - Bruxer Crown (Eggleston

- 1 Decl. Ex. 119)
- 2 ○ Dani Dental - Full Zirconia (Bruxer) (Jankowski Ex. 43)
- 3 ○ Diadem Precision Technology - Diazir (Eggleston Decl.,
- 4 Ex. 101)
- 5 ○ Drake Dental - Zir-Cast (Eggleston Decl. Ex. 96)
- 6 ○ Expertec - Full-Z (Eggleston Decl. Ex. 93)
- 7 ○ Fusion Dental Lab - “Full Solid Bruxer Zirconia”
- 8 (Jankowski Ex. 24)
- 9 ○ GPS Dental Lab - GPS BruxArt (Eggleston Decl. Ex.
- 10 114)
- 11 ○ Infinity Dental Lab - Bruxer Crowns (Eggleston Decl. Ex.
- 12 108)
- 13 ○ Kastle Mills - ZirCrown (Eggleston Decl. Ex. 100)
- 14 ○ Mascola Esthetics - Xtreme Bruxer (Eggleston Decl. Ex.
- 15 110)
- 16 ○ Old Dominion Milling Corp. - Bruxzer (Jankowski Ex.
- 17 32)
- 18 ○ Pittman Dental - ZirCAM All-Zirconia (Eggleston Decl.
- 19 Ex. 106)
- 20 ○ Pittman Dental - Bruxer Crown (Eggleston Decl. Ex. 120)
- 21 ○ R-dent Dental Laboratory - R-Brux (Eggleston Decl. Ex.
- 22 117)
- 23 ○ Showcase Dental Lab - Zir-Bruxer (Jankowski Exs. 30 &
- 24 38)
- 25 ○ Somer Dental Labs - Full Contour Zir (Eggleston Decl.
- 26 Ex. 104)
- 27 ○ Summers Dental Lab - BruxThetix (Eggleston Decl. Ex.
- 28 113)

- Sun Dental Labs - Suntech Full Zirconia (Eggleston Decl. Ex. 94)
- Technics Dental Lab - Tech/ZIR FC (Eggleston Decl. Ex. 105)
- Trachsel Dental - All Zirconia Bruxer (Jankowski Ex. 42)
- York Dental Lab - Bruxer (Eggleston Decl., Ex. 111)
- Many dental laboratories prominently promote their all-zirconia crowns for use by bruxers:
  - Barth Dental Labs - “ideal for bruxers” (Jankowski Ex. 37)
  - California Dental Arts - “Perfect for bruxers” (Eggleston Decl. Ex. 103)
  - China Dental Outsourcing - “primarily for bruxers and heavy biters” (Jankowski Ex. 39)
  - Drake Dental - “Recommended for Bruxers and Grinders” (Eggleston Decl. Ex. 96)
  - Expertec - “ideal for patients who brux” (Eggleston Decl. Ex. 93)
  - Infinity Dental Lab - “Bruxer Crowns” (Eggleston Decl. Ex. 108)
  - Sun Dental Labs - for “bruxers and grinders” (Eggleston Decl. Ex. 94)
  - York Dental Lab - “ideal restoration for bruxers” (Eggleston Decl. Ex. 111)
- Dentists have repeatedly written the word “Bruxzir” on prescription forms to refer to Defendant’s KDZ BRUXER all-zirconia crown or to a generic reference to an all-zirconia crown, not to identify Plaintiff Glidewell as a source.

(Mangum Decl. Ex. 53 (Brandon Dep. Tr.) at 56:23-57:6 & Exs. 59, 61, 62; Belton Decl. ¶¶ 9-11; Brady Decl. ¶¶ 9-11; Campbell Decl. ¶¶ 10-12; Colleran Decl. ¶¶ 10-12; Jacquinet Decl. ¶¶ 9-10; Murphy Decl. ¶¶ 9-11; Myers Decl. ¶¶ 9-10; Nussear Decl. ¶¶ 9-11; Richardson Decl. ¶ 10-12; Scott Decl. ¶¶ 9-11; Stephens Decl. ¶¶ 10-12; Sweet Decl. ¶¶ 8-10; Tobin Decl. ¶¶ 9-11)

- Showcase Dental Laboratory, a dental lab unaffiliated with Plaintiff Glidewell or Defendant Keating, has also received prescription forms from dentists ordering all-zirconia crowns that generically describe an all-zirconia crown as a “BruxZir,” “bruxzir,” or some variation thereof. (Eggleston Decl. Ex. 65 at 16-18 & Ex. 66 at 3-7.)
- Plaintiff owns BRUXZIR® as trademark.
- Defendant did not use its KDZ BRUXER mark in a manner likely to cause confusion among ordinary consumers as to the source, sponsorship, affiliation, or approval of the goods.
  - Plaintiff’s BRUXZIR mark is extremely weak because the term “BruxZir” is generic and/or commonly descriptive. (See evidence listed above in Section I.C.(a)(1).)
  - Declarations from thirteen dentists (identified in the following list) stating that they wrote “BruxZir,” “bruxzir,” or variations thereof on their prescription forms as a generic reference to an all-zirconia crown, not because they wanted a crown from Glidewell and not because they were otherwise confused that Glidewell and Keating were affiliated:

Belton Decl. ¶¶ 9-11, Ex. A;

Brady Decl. ¶¶ 9-11, Ex. A;

Campbell Decl. ¶¶ 10-12, Ex. A;

Colleran Decl. ¶¶ 10-12, Ex. A;

Jacquinet Decl. ¶¶ 9-10, Ex. A; Murphy Decl. ¶¶ 9-11, Ex. A;  
Myers Decl. ¶¶ 9-10, Ex. B; Nussear Decl. ¶¶ 9-11, Ex. A;  
Richardson Decl. ¶¶ 10-12, Ex. A; Scott Decl. ¶¶ 9-11, Ex. A;  
Stephens Decl. ¶¶ 10-12, Ex. A; Sweet Decl. ¶¶ 8-10, Ex. A; and  
Tobin Decl. ¶¶ 9-11, Ex. A.

- Plaintiff’s mark, as used in commerce, includes two separate words: “KDZ Bruxer” or “KDZ BRUXER.” In contrast, Glidewell’s mark is presented in commerce as a single word comprising a mixture of capital and small letters and two different fonts: *BruxZir*.
- Furthermore, in Glidewell’s mark, the “Zir” portion cuts off the edge of the “x” giving the appearance that the “Zir” letters appear forward of the word “Brux.”

**BruxZir®**

In contrast, Keating’s mark uses block letters side-by-side, often presented as part of a design that includes the name within an oval:



These additional elements help distinguish the parties’ marks as used in commerce.

- The second part of Keating’s mark is pronounced identically as Glidewell’s mark in its entirety. (See evidence listed immediately above in Section III.C.(1).) The first part of Keating’s mark, “KDZ,” has no similarly sounding counterpart in Glidewell’s mark

- The purchasing public (dentists) interpret Glidewell’s mark and the *second part* of Keating’s mark as a reference to the product itself: an all-zirconia dental restoration crown strong enough for bruxers. Dentists interpret the first part of Keating’s mark, “KDZ,” to mean “Keating Dental Zirconia,” thus identifying the source of the goods: Keating Dental Arts, Inc. (Keating Decl. ¶ 11; Stephens Decl. ¶ 10; Campbell Decl. ¶ 6.)<sup>6</sup>

6. Keating’s Affirmative Defense 2: No Likelihood of Confusion

*Sleekcraft* factors:

- Weakness of the Plaintiff’s Mark. Plaintiff’s BRUXZIR mark is extremely weak because the term “BruxZir” is generic and/or commonly descriptive. (See evidence listed above in Section I.C.(a).)
  - Proximity of Goods. Here, there is no dispute that the products offered for sale by Plaintiff under the mark BRUXZIR and by Defendant under the mark “KDZ Bruxer” are identical; all-zirconia dental restorations.
  - Similarity of Plaintiff’s and Defendant’s Marks.
- Sight: Defendant’s mark, as used in commerce, includes two separate words: “KDZ Bruxer” or “KDZ BRUXER.” In contrast, Plaintiff’s mark is presented in commerce as a single word comprising a mixture of capital and small letters and two different fonts: BruxZir. Furthermore, in Plaintiff’s mark, the “Zir” portion cuts off the edge of the “x” giving the appearance that the “Zir” letters appear forward of the word “Brux.”

<sup>6</sup> The declarations referenced in this section (II.C.(a)(3)) are the declarations filed in support of Keating Dental Arts, Inc.’s Motion for Summary Judgment of Noninfringement of Glidewell’s BRUXZIR® Trademark [Dkt. No. 86] and referenced in Defendant’s Statement of Uncontroverted Facts and Conclusions of Law in Support of that Motion.

**BruxZir®**

- In contrast, Keating’s mark uses block letters side-by-side, often presented as part of a design that includes the name within an oval:



- These additional elements help distinguish the parties’ marks as used in commerce.
- **Sound**: The second part of Keating’s mark is pronounced identically with Glidewell’s mark in its entirety. The first part of Keating’s mark, “KDZ,” has no similarly sounding counterpart in Glidewell’s mark.
- **Meaning**: The purchasing public (all are dentists) interpret Glidewell’s mark and the *second part* of Keating’s mark as a reference to the product itself: an all-zirconia dental restoration strong enough for bruxers. Dentists interpret the first part of Keating’s mark, “KDZ,” to mean “Keating Dental Zirconia,” thus identifying the source of the goods: Keating Dental Arts, Inc. (Keating Decl. ¶ 11; Stephens Decl. ¶ 10; Campbell Decl. ¶ 6.)<sup>7</sup>
- The only commonality between the marks is that they include the well-known dental term “brux” and the letter “z.” The appearance of “z” and “brux” are both fully explainable wholly aside from issues of identifying source, because both identify characteristics shared by the parties’ products; they are all-zirconia crowns for *bruxers*.

<sup>7</sup> The declarations referenced in sections III.C.(b)(3-4) and III.C(e) are the declarations filed in support of Keating’s Motion for Summary Judgment of Noninfringement of Glidewell’s **BRUXZIR® Trademark** [Dkt. No. 86] and referenced in Defendant’s Statement of Uncontroverted Facts and Conclusions of Law in Support of that Motion.



- 1           ○ Actual Confusion. Plaintiff cannot provide sufficient evidence of  
2           actual confusion. Dentists who wrote “BruxZir,” “bruxzir,” or  
3           variations thereof on the Keating Rx forms are not evidence of  
4           confusion between the marks. Those dentists were using variations of  
5           “bruxzir” as a generic term meaning all-zirconia crown for bruxers.  
6           (Mangum Decl. Ex. 53 (Brandon Dep. Tr.) at 56:23-57:6 & Exs. 59,  
7           61, 62; Belton Decl. ¶¶ 9-11; Brady Decl. ¶¶ 9-11; Campbell Decl. ¶¶  
8           10-12; Colleran Decl. ¶¶ 10-12; Jacquinot Decl. ¶¶ 9-10; Murphy  
9           Decl. ¶¶ 9-11; Myers Decl. ¶¶ 9-10; Nussear Decl. ¶¶ 9-11;  
10          Richardson Decl. ¶ 10-12; Scott Decl. ¶¶ 9-11; Stephens Decl. ¶¶ 10-  
11          12; Sweet Decl. ¶¶ 8-10; Tobin Decl. ¶¶ 9-11; Eggleston Decl. Ex. 65  
12          at 16-18 & Ex. 66 at 3-7.)
- 13          ○ Defendant’s Intent. Based on the perceived demand of its dentist  
14          customers for all-zirconia crowns, Keating decided to formally add an  
15          all-zirconia crown to its KDZ line of products (which had been  
16          introduced in 2006). (Mangum Decl., Ex. 54 (Keating Dep. Tr.) at  
17          43:15 – 45:12).<sup>8</sup> Because the new all-zirconia crown was specifically  
18          designed to replace gold crowns for bruxer patients, Mr. Keating  
19          wanted to call the new crown the “KDZ Bruxer.” (*Id.*). On March 31,  
20          2011, Keating sent a letter to all of its dentist customers referencing  
21          the increase in the cost of gold and offering a KDZ family of products  
22          consisting of:
- 23          • KDZ Bruxer (“Solid Zirconia for bruxer & grinder patients”);
  - 24          • KDZ Ultra (a rebranding of the existing KDZ Zirconia product)
- 25          (Keating Decl. ¶ 12); and

26

27          <sup>8</sup> The declarations referenced in this section (III.C(b)(5)) are the declarations filed  
28          in support of Defendant’s Motion for Summary Judgment Cancelling Glidewell’s  
        Trademark Registration [Dkt. No. 85] and referenced in Defendant’s Statement of  
        Uncontroverted Facts and Conclusions of Law in Support that Motion.

- 1 • KDZ Max (a ceramic pressed onto a zirconia base).
- 2 • (Keating Decl. Ex. F). Mr. Keating sought the advice of counsel, Mr.
- 3 Gourde, who performed a trademark search, to ensure Keating's use of the
- 4 name would not cause problems. (Mangum Decl., Ex. 54 (Keating Dep. Tr.)
- 5 at 43:15-45:12; Keating Decl. ¶ 10).
- 6 ○ Marketing/Advertising Channels. Plaintiff and Defendant each market
- 7 their products through Internet websites, magazine advertisements,
- 8 mailings to dentists, and trade shows. Here, there is no dispute that the
- 9 marketing channels used by Glidewell and Keating overlap.
- 10 • Consumer's Degree of Care. The relevant consumers in this case are dentists
- 11 who are highly educated and specially trained professionals. The products in
- 12 this case are dental restorations, regulated medical products that impact the
- 13 well-being of patients if not designed, manufactured, or affixed properly.
- 14 Dentists necessarily put great care into the treatment of their patients, and
- 15 they correspondingly put great care into the selection of a dental laboratory to
- 16 manufacture dental restorations for their patients. *See Accuride Int'l, Inc. v.*
- 17 *Accuride Corp.*, 871 F.2d 1531, 1537 (9th Cir. 1989) (holding factor weighed
- 18 heavily against a finding of likelihood of confusion where purchasers were
- 19 highly specialized professionals expected to exercise a high degree of care.)
- 20 • Product Line Expansion. Here, the subject products already compete in the
- 21 same market and are advertised in overlapping marketing channels. Thus,
- 22 this factor is not relevant.

### 23 7. Keating's Affirmative Defense 3: Estoppel

- 24 • Plaintiff intentionally chose to adopt, use, and register the trademark
- 25 BRUXZIR, and NOT the words BRUX or BRUXER. On information
- 26 and belief, Defendant coined its BRUXZIR mark as a corruption of the
- 27 generic term BRUXER and the material that is now commonly used to
- 28

1 fabricate such bruxer devices, zirconia. Because of the phonetic  
2 similarity of the last syllable of BRUXER and the first syllable of  
3 ZIRCONIA, Plaintiff collapsed the two (by replacing BRUXER's  
4 second syllable with ZIRCONIA's first syllable) to form a single word  
5 BRUXZIR. Having intentionally selected and used a trademark that  
6 adds three distinct letters "ZIR" (an abbreviation for "zirconia", the  
7 material from which those products are made) to the end of the  
8 generic/descriptive word BRUX (thus BRUX+ZIR = BRUXZIR),  
9 Glidewell cannot now ask the Court to treat Glidewell's trademark as  
10 if it consisted ONLY of that generic/descriptive word BRUX or  
11 BRUXER (and ignore the three letters ZIR that Glidewell added to  
12 create its alleged trademark).

13 8. Keating's Affirmative Defense 4: Trademark  
14 Misuse/Unclean Hands/Unfair Competition

15 • Plaintiff has engaged in predatory or anticompetitive conduct:

16 Plaintiff has relied on the registration of its BRUXZIR mark as grounds for  
17 threatening trademark infringement suits against any other dental laboratory using  
18 "Brux" or "Bruxer" in a mark for an all-zirconia crown. (Jankowski Decl., Ex. 6  
19 (Allred Dep. Tr.) at 213:19-264:13 & Exs. 24-34.)<sup>9</sup> Specifically, Plaintiff sent  
20 cease-and-desist letters to at least the following dental labs:

- 21 • Assured Dental Lab - "Z-Brux" (Jankowski Decl. Ex. 28)
- 22 • Authentic Dental Lab - "Brux" (Jankowski Decl. Ex. 27)
- 23 • China Dental Outsourcing - "Bruxer All Zirconia" (Jankowski  
24 Decl. Ex. 29)
- 25 • Fusion Dental Lab - "Full Solid Bruxer Zirconia" (Jankowski Decl.

26 <sup>9</sup> The declarations referenced in this section (II.C(c)(1)) are the declarations filed in  
27 support of Defendant's Motion for Summary Judgment Cancelling Glidewell's  
28 Trademark Registration [Dkt. No. 85] and referenced in Defendant's Statement of  
Uncontroverted Facts and Conclusions of Law in Support that Motion.

Ex. 24)

- Old Dominion Milling Corp. - “Bruxzer” (Jankowski Decl. Ex. 32)
- Pittman Dental - “Bruxer All-Zirconia Crown” (Jankowski Decl. Ex. 25)
- R-dent Dental Laboratory - “R-Brux” (Jankowski Decl. Ex. 26)
- Showcase Dental Lab - “Zir-Bruxer”) (Jankowski Decl. Ex. 30)

In each instance, the dental laboratory chose to change its name rather than face the risk of a lawsuit in Federal court versus Plaintiff. (*Id.*; Jankowski Decl. Ex. 6 (Allred Dep. Tr.) at 213:19-264:13.)

- Plaintiff had a specific intent to monopolize for all-zirconian bruxer:

Please see the evidence cited in the previous section (II.C(c)(1)).

- There is a dangerous probability Plaintiff could achieve monopoly power:

Please see the evidence cited above in section II.C(c)(1). Furthermore, Plaintiff Glidewell Laboratories, founded in 1970, is already the largest dental laboratory in the U.S. (Jankowski Decl., Ex. 6 (Allred Dep. Tr.) at 51).

9. Keating’s Counterclaim 4: Cancellation of Trademark

- Plaintiff’s BRUXZIR trademark is invalid due to generic-ness and because the terms “bruxzir” is commonly descriptive:

Please see the evidence cited above in Section 7(Defendant)(c)(1).

- Plaintiff’s BRUXZIR mark has not acquired “secondary meaning”:

In addition to describing the intended user of the product—a bruxer—the evidence establishes that dentists and dental labs understand the term BRUXZIR to denote or at least describe full zirconia crown products that are ideal for bruxers. Plaintiff’s witnesses testified to such descriptive attributes of the “brux” and “zir” elements of the mark. (*See* evidence cited above in Section I.C(a)(3).) Plaintiff has failed to submit any survey evidence or other evidence showing an association of its BRUXZIR mark in the minds of the relevant consumers. Additionally, Plaintiff has

1 failed to submit any evidence that its advertising was effective in establishing  
2 secondary meaning in the minds of the relevant consumers

3 5. Keating's Affirmative Defense 5: Fair Use

- 4 • Defendant does not use BRUXER in its mark to indicate source, but  
5 rather to describe the goods to which the mark is applied. (Mangum  
6 Decl., Ex. 54 (Keating Dep. Tr.) at 83:11-15.)<sup>10</sup>
- 7 • Defendant used its KDZ BRUXER marks "fairly and in good faith."  
8 (Please see evidence recited in Section III.C(b)(5), above.)
- 9 • Defendant used the term "BRUXER" "[o]nly to describe its goods."  
10 (Mangum Decl., Ex. 54 (Keating Dep. Tr.) at 83:11-15; *see also*  
11 evidence recited in Section I.C(a)(1), above.)

12 8. In view of the admitted facts and the elements required to establish the  
13 claims, counterclaims and affirmative defenses, the following issues remain to be  
14 tried:

- 15 a. Whether BruxZir is a valid, protectable trademark.
- 16 b. Whether Keating's use of KDZ Bruxer, without Glidewell's  
17 consent, is likely to cause consumer confusion.
- 18 c. The amount and elements of Glidewell's remedy for Keating's  
19 infringement.

20 9. All discovery is complete.

21 10. All disclosures under Fed. R. Civ. P. 26(a)(3) have been made.

22 The joint exhibit list of the parties has been filed under separate cover as  
23 required by L.R. 16-6.1. Unless all parties agree that an exhibit shall be withdrawn,  
24 all exhibits will be admitted without objection at trial, except those exhibits listed in  
25 the attached objections to the exhibits.

26 Glidewell's objections to the exhibits are attached as Exhibit A and

27  
28 <sup>10</sup> See fn. 5 (*supra*).

1 incorporated herein by reference.

2 Keating objects to the following exhibits: 3, 5, 40-42, 48-49, 57-58, 69, 71,  
3 72, 503-506, 510-514, 523-524, 530-538, 556-558, 560, 562-569, 572-573, 575-  
4 576, 578-591, 593-606, 610-613, 616, 658-659, 661-706, 708-711, 713-729, 731-  
5 941, 961-976, 980-985, 988-992, 994, 996-997, 1000-1004, 1006-1028, 1034-1037,  
6 1044-1045, 1047, 1049-1050, 1052, 1054-1168, 1170-1172, 1174-1171, 1194-  
7 1195, 1197-1198, 1200-1201, 1203-1204, 1206-1209, 1211-1216, 1219-1226,  
8 1228-1239, 1241-1242, 1244-1247, 1249-1251, 1253, 1256-1320, 1322-1341,  
9 1343-1468, 1470-1473, 1475-1476, 1482-1488, 1491-1586.

10 Keating's objections to the exhibits are attached as Exhibit B.

11 11. Witness Lists of the parties have been filed with the Court.

12 Only the witnesses identified in the lists will be permitted to testify (other  
13 than solely for impeachment).

14 The parties do not intend to present evidence by way of deposition testimony.  
15 No depositions will be lodged with the Clerk for this purpose.

16 12. The following law and motion matters and motions in limine, and no  
17 others, are pending or contemplated:

- 18 a. Glidewell's Motion to exclude evidence or argument regarding  
19 purported generic use of BruxZir or bruxer for full contour  
20 zirconia crowns after April 2011.
- 21 b. Glidewell's Motion to exclude evidence or argument regarding  
22 webpages from a source other than the parties and Authorized  
23 BruxZir Labs.
- 24 c. Glidewell's Motion to exclude to exclude testimony from  
25 Keating's expert Dr. David Eggelston relating to genericness,  
26 and to exclude any testimony from Dr. Eggleston relating to  
27 likelihood of confusion.  
28

- d. Glidewell's Motion to exclude testimony from Keating's expert Lori Boatright relating to genericness, and to exclude any testimony from Boatwright relating to likelihood of confusion.
- e. Glidewell's Motion to exclude evidence or argument regarding Keating's petition to cancel the BruxZir registration and its opposition to Glidewell's application to register BruxZir for the Glidewell milling blanks.
- f. Glidewell's Motion to exclude evidence or argument regarding content of advice of counsel regarding whether KDZ Bruxer was free to use.
- g. Glidewell's Motion to exclude evidence or argument that Keating is purportedly being bullied by Glidewell or otherwise attempting to excite sympathy based on Keating's relative size.
- h. Glidewell's Motion to exclude evidence or argument regarding any statements or rulings by the Court on any party's motions, including summary judgment motions.
- i. Glidewell's Motion to exclude evidence or argument regarding any offers to compromise.
- j. Keating's Motion to exclude testimony of David J. Franklyn.
- k. Keating's Motion to exclude testimony of Dr. Ronald Goldstein.
- l. Keating's Motion to exclude untimely testimony of Nicole Fallon.
- m. Keating's Motion to exclude testimony of Seven Dentists.
- n. Keating's Motion to exclude untimely webpage evidence.
- o. Keating's Motion to exclude hearsay and opinion testimony of Glidewell employees.
- p. Keating's Motion to exclude hearsay testimony regarding Glidewell's Exhibit 15.



q. Keating's Motion to exclude evidence of past terminations, past restitution payments, and past allegations of harassment.

r. Keating's Motion to exclude documents produced after discovery cut-off date.

13. The parties do not request bifurcation of any issues for trial.

14. The foregoing admissions having been made by the parties, and the parties having specified the foregoing issues remaining to be litigated, this Final Pretrial Conference Order shall supersede the pleadings and govern the course of the trial of this cause, unless modified to prevent manifest injustice.

Dated: \_\_\_\_\_

UNITED STATES DISTRICT JUDGE

Approved as to form and content.

**Snell & Wilmer**  
LLP

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Dated: January 17, 2013

SNELL & WILMER L.L.P.

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